



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 97-223-I)

Application of: )  
)  
**Ravi Kapur et al.** )  
)  
Serial No.: **09/624,131** )  
)  
Filing Date: **July 21,2000** )  
)  
For: **Miniaturized Cell Array Methods and** )  
**Apparatus for Cell-Based Screening** )

Examiner: **Lisa V. Cook**  
Group Art Unit: **1641**  
Confirmation No.: **4910**

Mail Stop: Petition  
Commissioner for Patents  
P O Box 1450  
Alexandria, VA 22313-1450

**RECONSIDERATION PETITION UNDER 37 CFR 1.182**

Dear Sir:

The Applicants hereby petition for reconsideration of the dismissal of petition filed on September 27, 2005 under 37 CFR 1.182 requesting withdrawal of terminal disclaimer filed on April 2, 2003 and entering of the terminal disclaimer filed September 27, 2005.

The Patent Office dismissed the original petition stating that it was not clear why Applicants were filing a new terminal disclaimer.

On November 7, 2003 (effective as of August 28, 2002) rights in the pending application (Serial No. 09/624,131) and the patent (US 6,416,959) over which terminal disclosure was filed were assigned to Carl Zeiss Jena GmbH as part of security agreement. Please refer to Exhibit A.

The original terminal disclaimer was filed on April 2, 2003 and inadvertently listed Cellomic, Inc. as owner of US 09/624,131 and US 6,416,959, while the owner of both the application and the patent at the time was Carl Zeiss Jena GmbH. Thus, the original terminal disclaimer was in error although both US 09/624,131 and US 6,416,959 were commonly owned.

The rights to US 09/624,131 and US 6,416,959 were assigned back to Cellomics, Inc. on August 30, 2005. Please refer to Exhibit B.

The Applicants therefore seek withdrawal of the original terminal disclaimer filed on April 2, 2003 and entering of the terminal disclaimer filed September 27, 2005. The Applicants note that the terminal disclaimer filed September 27, 2005 provides the same disclaimer as in the terminal disclaimer executed on April 1, 2003. Thus, withdrawal of the terminal disclaimer executed on April 1, 2003 does not result in a reopening of the question of the propriety of the double patenting rejection.

The Applicants also submit that the reception desk of McDonnell Boehnen Hulbert & Berghoff was relocated from the 32<sup>nd</sup> floor to the 31<sup>st</sup> floor of the same building after renovations. Hence, the official correspondence address has changed and lists the 31<sup>st</sup> floor instead of the 32<sup>nd</sup> floor.

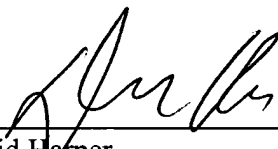
The Applicants also believe that there are no fees due since the petition fee and terminal disclaimer fees were paid with the filing made on September 27, 2005.

If there are any questions, the Patent Office is encouraged to contact the undersigned attorney.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff LLP**

Dated: January 17, 2006

By: \_\_\_\_\_

  
David Harper  
Reg. No. 42,636  
**McDonnell Boehnen Hulbert & Berghoff LLP**  
31<sup>st</sup> Floor  
300 South Wacker Drive  
Chicago, Illinois 60606  
Telephone 312-913-0001  
Facsimile 312-913-0002

## PATENT ASSIGNMENT

WHEREAS, Cellomics, Inc., having its registered office at 100 Technology Drive, Pittsburgh, PA 15219 (hereinafter "Assignor"), is the owner of the entire right, title and interest in and to certain patents and patent applications listed on SCHEDULE 1 annexed hereto (collectively referred to as the "Patents"); and

WHEREAS, Carl Zeiss Jena GmbH, having its registered office at Carl-Zeiss-Promenade 10, 07745 Jena, Germany (hereinafter "Assignee"), and Assignor are parties to the following agreements (collectively the "Agreements"): (i) Recapitalization and Loan Agreement effective as of August 28, 2002 ("Recapitalization Agreement"); (ii) Agency Agreement effective as of August 28, 2002 ("Agency Agreement"); Assignment and License Agreement effective as of August 28, 2002 ("License Agreement") pursuant to which Assignee is to acquire all right, title, and interest in and to the Patents as provided herein; and (iv) Memorandum of Understanding effective as of August 29, 2002 ("MOU").

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, Assignor hereby sells, assigns and transfers to Assignee the entire right, title and interest in and to the Patents throughout the world and the inventions and designs covered thereby, including the right to claim priority and the right to any continuation, division, or substitute application thereof and the right to any reissue, restoration, extension or reexamination of any patent thereof, subject to all liens, claims and encumbrances thereon, including, without limitation, those liens, claims and encumbrances identified in Schedule 1 hereto, the same to be held and enjoyed by Assignee for its own use and enjoyment, and for the use and enjoyment of its successors, assigns and legal representatives, to the end of the terms for which the Patents have been or will be granted, as fully and entirely as the same would have been held and enjoyed by Assignor if this assignment had not been made.

The sale, assignment and transfer to Assignee hereunder is subject to paragraph 3 of the MOU, which states as follows: "Until the Merger [as defined within the Agreements], the interests of Zeiss under the License Agreement shall be deemed held for the benefit of Zeiss and all the Additional Lenders [as defined within the Agreements]. The exercise of any rights under the License Agreement shall be subject to the provisions of the Agency Agreement as if the License Agreement were specifically referenced therein."

Assignor agrees that when requested by Assignee it will, at the sole cost of Assignee, execute all documents necessary or desirable to properly vest full right, title and interest in and to all Patents throughout the world in the name of Assignee or which, in the sole judgment of Assignee, may be necessary to obtain, maintain, issue or enforce said Patents.

IN WITNESS WHEREOF, Cellomics, Inc. has caused this Patent Assignment to be executed and delivered this 7<sup>th</sup> day of November, 2003, to be effective as of August 28, 2002.

Cellomics, Inc.

By [Signature]

Title VP Finance

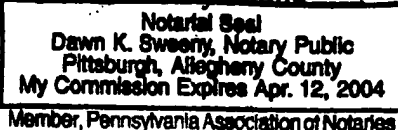
State of Pennsylvania )

County of Allegheny ) ss.:

On this 7<sup>th</sup> day of November, 2003, before me personally came Jeffrey Kowitz to me known, who being by me duly sworn, did depose and say that he/she is VP Finance of Cellomics, Inc. and which executed the foregoing instrument; and that he/she signed his/her name thereto by order of the Board of Directors of Cellomics, Inc.

[Notarial Seal]

[Signature]  
Notary Public



**SCHEDULE 1**

**1. PATENTS AND PATENT APPLICATIONS**

Country	Filing date	Serial No.	Title/Inventors	Status
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United States	7/21/2000	09/624,131	Kapur and Giuliano, Miniaturized Cell Array Methods and Apparatus for Cell- Based Screening	Pending
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**Toxin Characterization**

United States	2/24/00	09/513,783	A System for Cell Based Screening, Giuliano and Kapur	US Patent No. 6,416,959
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## Assignments on the Web &gt; Patent Query

## Patent Assignment Abstract of Title

**NOTE: Results display only for issued patents and published applications.  
For pending or abandoned applications please consult USPTO staff.**

## Total Assignments: 2

**Patent #:** [6416959](#)    **Issue Dt:** 07/09/2002    **Application #:** 09513783    **Filing Dt:** 02/25/2000**Inventors:** Kenneth Giuliano, Ravi Kapur**Title:** System for cell-based screening

## Assignment: 1

**Reel/Frame:** [014692/0942](#)**Recorded:** 11/17/2003**Pages:** 14**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** [CELLOMICS, INC.](#)**Exec Dt:** 11/11/2003**Assignee:** [CARL ZEISS JENA GMBH](#)

CARL-SEISS-PROMENADE 10

JENNA, GERMANY 07745

**Correspondent:** METZ LEWIS LLC

PHILIP E. LEVY, ESQ.

11 STANWIX STREET

18TH FLOOR

PITTSBURGH, PA 15222

## Assignment: 2

**Reel/Frame:** [016864/0619](#)**Recorded:** 12/07/2005**Pages:** 22**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignors:** [CARL ZEISS JENA GMBH](#)**Exec Dt:** 08/30/2005[CARL ZEISS MICROIMAGING, INC.](#)**Exec Dt:** 08/30/2005**Assignee:** [CELLOMICS, INC.](#)

100 TECHNOLOGY DRIVE

PITTSBURGH, PENNSYLVANIA 15219

**Correspondent:** BAKER & HOSTETLER LLP

1050 CONNECTICUT AVENUE, N.W.

WASHINGTON SQUARE, SUITE 1100

WASHINGTON, DC 20036-5304

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## PATENT ASSIGNMENT

WHEREAS, Carl Zeiss Jena GmbH, having its registered office at Carl-Zeiss-Promenade 10, 07745 Jena, Germany, and Carl Zeiss MicroImaging, Inc., having its principal place of business at One Zeiss Drive, Thornwood, New York (hereinafter, collectively, "Assignors"), are the owner of the Patents referred to below; and

WHEREAS, Cellomics, Inc., having its registered office at 100 Technology Drive, Pittsburgh, PA 15219 (hereinafter "Assignee"), and Carl Zeiss MicroImaging, Inc. are parties to a certain Agreement and Plan of Merger, dated as of August 3, 2005 and, in conjunction with such Agreement, Assignee is to acquire all right, title, and interest in and to the Patents as provided herein.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, Assignors hereby sell, assign and transfer to Assignee the entire right, title and interest in and to the patents and patent applications listed on SCHEDULE 1 annexed hereto throughout the world and the inventions and designs covered thereby, including the right to claim priority and the right to any continuation, division, or substitute application thereof and the right to any reissue, restoration, extension or reexamination of any patent thereof, subject to all existing licenses with respect thereto, including, without limitation, the Patent License Agreement by and between Carl Zeiss MicroImaging, Inc. and Cellomics, effective as of August 30, 2005, and all liens, claims and encumbrances thereon, including, without limitation, those liens, claims and encumbrances identified in SCHEDULE 1 annexed hereto (the "Patents"), the same to be held and enjoyed by Assignee for its own use and enjoyment, and for the use and enjoyment of its successors, assigns and legal representatives, to the end of the terms for which the Patents have been or will be granted, as fully and entirely as the same would have been held and enjoyed by Assignor if this assignment had not been made.

Assignors agree that when requested by Assignee they will, at the sole cost and expense of Assignee, execute all documents necessary or desirable to properly vest full right, title and interest in and to the Patents in the name of Assignee or to obtain, maintain, issue or enforce said Patents.

IN WITNESS WHEREOF, Carl Zeiss Jena GmbH and Carl Zeiss MicroImaging, Inc. have caused this Patent Assignment to be executed and delivered this 31st day of August, 2005, to be effective as of August 31, 2005.

Carl Zeiss Jena GmbH

By [Signature]

Title: VP+GM Microscopy

i.v. [Signature]

Carl Zeiss MicroImaging, Inc.

By \_\_\_\_\_

Title: \_\_\_\_\_

IN WITNESS WHEREOF, Carl Zeiss Jena GmbH and Carl Zeiss MicroImaging, Inc. have caused this Patent Assignment to be executed and delivered this 31st day of August, 2005, to be effective as of August, 31, 2005.

Carl Zeiss Jena GmbH

By \_\_\_\_\_

Title: \_\_\_\_\_

Carl Zeiss MicroImaging, Inc.

By [Signature]

Title: Vice President Finance



**SCHEDULE 1**

**1. PATENTS AND PATENT APPLICATIONS**

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## Assignment: 1

**Reel/Frame:** [014692/0942](#)**Recorded:** 11/17/2003**Pages:** 14**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** [CELLOMICS, INC.](#)**Exec Dt:** 11/11/2003**Assignee:** [CARL ZEISS JENA GMBH](#)

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JENNA, GERMANY 07745

**Correspondent:** METZ LEWIS LLC

PHILIP E. LEVY, ESQ.

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## Assignment: 2

**Reel/Frame:** [016864/0619](#)**Recorded:** 12/07/2005**Pages:** 22**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignors:** [CARL ZEISS JENA GMBH](#)**Exec Dt:** 08/30/2005[CARL ZEISS MICROIMAGING, INC.](#)**Exec Dt:** 08/30/2005**Assignee:** [CELLOMICS, INC.](#)

100 TECHNOLOGY DRIVE

PITTSBURGH, PENNSYLVANIA 15219

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. 97,223-I)

In re Application of:

Ravi Kapur, et al.

Serial No.: 09/624,131

Filing Date: July 21, 2000

For: Miniaturized Cell Array Methods and Apparatus for  
Cell-Based Screening

Group Art Unit: 1641

Examiner: Lisa V. Cook

Confirmation No. 4910

Mail Stop: PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached:

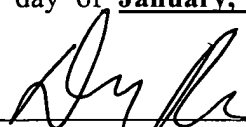
- ☒ Transmittal Letter (1 sheet);
- ☒ Reconsideration Petition Under 37 CFR § 1.182 (2 sheets);
- ☒ Exhibit A
- ☒ Exhibit B
- ☒ Return Receipt Postcard

2. With respect to additional fees:

☒ No fee is required.

3. Please charge any additional fees or credit overpayment to Deposit Account No.  
13-2490.

4. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.10:** The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as express mail in an envelope addressed to: Mail Stop: PETITION, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 17<sup>th</sup> day of January, 2005. Express Mail No. **EV59649283US**.

By:   
David S. Harper  
Reg. No. 42,636

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